

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HYMAN R. LUBOWITZ
and
CLYDE H. SHEPPARD

Appeal No. 1999-1335
Application No. 08/463,437

ON BRIEF

Before GARRIS, KRATZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

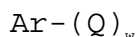
This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 47 through 57, 64 through 66, and 68 through 71.¹ Claims 1 through 5, 7 through 20, 24 through 44, 72, and 73, which are the only other pending claims, have been allowed.² (Examiner's answer, page 3.)

¹ In response to the final Office action of December 1, 1997 (paper 10), the appellants submitted an amendment under 37 CFR § 1.116 (1997) on March 16, 1998 (paper 12) proposing, inter alia, a change to claim 64. According to the examiner, this amendment has been entered. (Advisory action of April 29, 1998, paper 14.)

² Claims 6 and 21 through 23 were canceled subsequent to the final Office action in the amendments under 37 CFR § 1.116 filed March 16, 1998 and August 5, 1998, papers 12 and 21, respectively.

The subject matter on appeal relates to a multidimensional polyester oligomer of a particular general formula. Further details of this appealed subject matter are recited in illustrative claim 47 reproduced below:

47. A multidimensional polyester oligomer of the general formula:



wherein Ar = an aromatic hydrocarbon radical of valence w;
w = an integer greater than or equal to 3;
and
Q = a hydrocarbon radical that includes at least one ester linkage and a terminal crosslinking end-cap radical.

The examiner relies on the following reference as evidence of unpatentability under the judicially created doctrine of obviousness-type double patenting:

Lubowitz et al.	5,175,233	Dec. 29, 1992
('233 patent)		

Claims 47 through 57, 64 through 66, and 68 through 71 on appeal stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 through 14 of the '233 patent. (Examiner's answer, page 5.)

We affirm the aforementioned rejection.³

(Advisory actions of April 29, 1998 and August 18, 1998, papers 14 and 22, respectively.)

³ The appellants state: "Each claim stands separately; arguments for the patentability of each claim appear in the Argument section." (Appeal brief, p. 6.) To the contrary, we do not find any specific arguments for the separate patentability of each claim either in the appeal brief or reply brief. We therefore limit our discussion to representative claim 47. See 37 CFR § 1.192(c)(7) (1997).

The appellants do not contest the examiner's determination (examiner's answer, pages 5-6) that the claimed subject matter and the subject matter described in the claims of the '233 patent are patentably indistinct from each other. Rather, it is the appellants' principal argument that an obviousness-type double patenting rejection is not appropriate in this instance because the delays in the issuance of a patent from this application resulted solely from "circumstances beyond Applicant's control or through PTO nonfeasance or malfeasance." (Appeal brief, page 7.)

We find no merit in the appellants' argument.

The judicially-created doctrine of obviousness-type double patenting prohibits a party from obtaining an extension of the right to exclude granted through claims in a later patent that are not patentably distinct from claims in a commonly-owned earlier patent. Ely Lilly & Co. v. Barr Laboratories, Inc., 251 F.3d 955, 967, 58 USPQ2d 1869, 1877-78 (Fed. Cir. 2001) (citing In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985)). According to our reviewing court, the fundamental reason for the doctrine of obviousness-type double patenting is to prevent unjustified timewise extension of the right to exclude granted by a patent, regardless of how the extension arose. Ely Lilly, 251 F.3d at 967-68, 58 USPQ2d at 1878.

From these legal principles, it is clear that the primary focus in this obviousness-type double patenting situation must be on whether the claims of the present application are patentably indistinct from the claims of the '233 patent. It is not, as the

appellants would have us believe, whether delays in the prosecution of the application were caused by the PTO.⁴ As we indicated above, the appellants do not contest the examiner's determination that appealed claim 47 is patentably indistinct from the claims of the '233 patent. Under these circumstances, we must uphold the examiner's rejection under the judicially created doctrine of obviousness-type double patenting as a matter of law.

The appellants argue that "[f]orcing a terminal disclaimer robs him [sic, them] of protection he otherwise would have had if the government had not intervened and caused delay in the prosecution of his application." (Appeal brief, page 7.) This is incorrect. The examiner would have been justified in rejecting the appealed claims on obviousness-type double patenting over the claims of the '233 patent even if no delays had been present.

⁴ To the extent that the appellants believe that these delays justify a two-way double patenting test, we note that the facts of the present case are removed from the facts of In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1992). Unlike Braat, the inventive entity of the present application is the same as that of the '233 patent. In addition, the invention claimed in the '233 patent is not a later-filed improvement of the present invention. Further, the claims of the present application and the claims of the application which matured into the '233 patent could have been combined in a single continuation-in-part application. In re Berg, 140 F.3d 1428, 1433, 46 USPQ2d 1226, 1230 (Fed. Cir. 1998) ("[B]ecause Berg could have filed the claims of its separate applications in a single application, and it simply chose to file two applications despite nearly identical disclosures, Berg is not entitled to the two-way test."). In any event, we note that the appellants do not dispute the examiner's determination (answer, p. 6) that the claims of the present application and the claims of the '233 patent are patentably indistinct from each other under the two-way double patenting test.

For these reasons and those set forth in the answer, we affirm the examiner's rejection under the judicially created doctrine of obviousness-type double patenting of claims 47 through 57, 64 through 66, and 68 through 71 as unpatentable over claims 1 through 14 of the '233 patent.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Appeal No. 1999-1335
Application No. 08/463,437

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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